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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------------|------------------|
| 10/659,802 | 09/10/2003 | Patrick Fogarty | TOSK-007CON | 5245 |
| 24353 7590 02/12/2007 BOZICEVIC, FIELD & FRANCIS LLP 1900 UNIVERSITY AVENUE SUITE 200 EAST PALO ALTO, CA 94303 | | | EXAMINER MONTANARI, DAVID A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1632 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 02/12/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/659,802

Applicant(s)

FOGARTY, PATRICK

Examiner

David Montanari

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11,13-15,18,27,30,31 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11,13-15,18,27,30,31 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 11/20/2006.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/20/2006 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 11, 13-15, 18, 27, 30-31, and 34 remain rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a method of inserting an exogenous nucleic acid into the genome of a rodent, wherein said method comprises introducing into said rodent a P-element derived vector comprising a pair of P-element transposase recognized insertion sequences flanking at least one transcriptionally active gene that is at least 50 bp proximity to one of the P-element transposase recognized sequences and a transposase domain, and a method of inserting an exogenous nucleic acid into the genome of a rodent, wherein said method comprises introducing into said rodent a P-element derived vector comprising a pair of P-element transposase recognized insertion sequences flanking at least one

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transcriptionally active gene that is at least 50 bp proximity to one of the P-element transposase recognized sequences, wherein said method further comprises inserting a second P-element vector comprising a transposase domain, and cells from said rodent, does not reasonably provide enablement for a method of inserting an exogenous nucleic acid into the genome of any rodent, wherein said method comprises introducing into said rodent any P-element derived vector comprising said exogenous nucleic acid, and cells from said rodent. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims for reasons of record in the office action mailed 8/30/2005.

Response to Arguments

Applicants argue in amendment filed 10/17/2006 that the present application provides sufficient disclosure to enable the invention to the full scope of the pending claims. Applicants argue that the instant specification provides sufficient disclosure to enable the claimed method using a P-element derived vector to make any transgenic rodent. The Examiner agrees with the Applicant that given the current disclosure of the instant specification and the supporting literature available to the skilled artisan at the time of filing that the claimed method would be enabling using the P-element vector comprising a pair of P-element transposase recognized insertion sequences flanking at least one transcriptionally active gene that is at least 50 bp proximity to one of the P-element transposase recognized sequences. At issue now is the claiming of the P-element vector used in the claimed method to fully enable the claimed method

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based upon Applicants disclosure in the instant specification. The claim language currently used in the instant claims does not adequately claim what was done by the applicant as discussed in the instant specification. The language used in the scope of enablement rejection above, in the case of a potential allowance, would result in less issues if the claims are deemed allowable. Thus for reasons of record in the office action mailed 5/18/2006 and above the rejection is maintained.

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Montanari whose telephone number is 1-571-272-3108. The examiner can normally be reached on M-Tr 8-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on 1-571-272-4517. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

David A. Montanari, Ph.D.



DEBORAH CROUCH
PRIMARY EXAMINER
GROUP 1800-1630